REMARKS

Claims 1, 4 – 15, 18, 20 – 37, 39 – 44, 47, 49 – 61, 63 – 80, and 82 – 88 are pending in this application. On page 1 of the Final Office Action mailed September 11, 2008, the pending claims are reflected as "Claims 1, 4 – 15, 18, 20 – 37, 39 – 44, 47, 49 – 61, 63 – 80, and 82". It is believed this is a typographical error. Reconsideration of the allowability of the pending claims and withdrawal of the rejections to the pending claims, as well as to the finality of the Final Office Action of September 11, 2008, are respectfully requested for at least the following reasons.

PREMATURE FINAL OFFICE ACTION AS REJECTIONS ARE BASED ON PRIOR ART NOT OF RECORD

According to MPEP §706.07, "[b]efore final rejection is in order … the invention as disclosed and claimed should be thoroughly searched in the first action **and the references fully applied**" (emphasis added). "A second or any subsequent action on the merits in any application … should not be made final if it includes a rejection, on prior art not of record" (MPEP 706.07(a)). Here, claims 4, 6, 8 – 14, 31 – 34, 47, 49, 51 – 57, and 74 – 77 under 35 USC 103(a) stand rejected as being unpatentable over Shiimori and Cocotis and further in view of allegedly well-known prior art, wherein the asserted "well-known prior art" is not of record. In the previous response, Applicant pointed out the errors in the Office's application of asserted well-known prior art to reject claims 4, 6, 8 – 14, 31 – 34, 47, 49, 51 – 57, and 74 – 77. Applicant properly requested concrete evidence or an affidavit to support the rejections of these claims. The Office did not provide the requested evidence or affidavit. Now, in this Final Office Action, many of the claims of this application stand rejected on alleged prior art that is not of record, but rather seemingly based on the Office's personal knowledge and opinion of what is well-known art. Accordingly, the finality of this Office Action should be withdrawn and the requested documents provided.

Specifically, claims 4, 6, 8 – 14, 31 – 34, 47, 49, 51 – 57, and 74 – 77 stand rejected based on the Office's opinion that "it is well known and obvious to a person of ordinary skill in the art to receive a confirmation after a transmission … to notify the photo shop that the images have been sent correctly." Again, **Applicant is not aware of any common knowledge or well-known prior art indicating that the specific applications of the asserted "well-known prior art" and motivations**

for supplying these limitations are known in the art of the invention. In the Response dated June 30, 2008, Applicant requested documentary evidence or an affidavit proving the alleged "well-known prior art." However, even upon Applicant's traverse of the Official Notice and request for corroborating concrete evidence, the Office has failed to provide any corroborating documentary evidence of this alleged well-known prior art in the outstanding Final Office Action of September 11, 2008. If the Office believed that Applicant's traverse of the Official notice was inadequate, the Office further failed to provide any explanation of why Applicant's statement traversing the Official Notice was inadequate. Thus, the Office's undocumented "well-known prior art" should not be considered to be common knowledge or well-known in the art, unless it can otherwise be proven with documentary evidence.

Moreover, rather than providing the requested documentary evidence of the official notice of well-known prior art, and in support of the Examiner's inaction to provide the requested evidence, it is respectfully submitted that the Examiner relies on a seeming misinterpretation of the procedure set forth by MPEP §2144.03. The Examiner asserts "[a]ccording to MPEP 2144.03, *if the applicant does not traverse the Office's assertion of official notice by the next action*, the common knowledge or well-known in the art statement is taken to the admitted prior art" (Office Action, pg 4, section "c"). However, Applicant respectfully submits that MPEP 2144.03 states that "the **examiner must** provide documentary evidence **in the next Office action** if the rejection is to be maintained. [T]he Board [or examiner] **must** point to some concrete evidence in the record in support of these findings" to satisfy the substantial evidence test. If the examiner is relying on personal knowledge to support the finding of what is known in the art, the examiner **must** provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding. See 37 CFR 1.104(d)(2)."

Here, the Examiner failed to provide the requested documentary evidence of the alleged well-known prior art or the affidavit, and in the alternative, further failed to explain whether Applicant's traverse was adequate or a corresponding explanation of why the traverse was not adequate. As a result, **in this Final Office Action many of the claims of this application stand rejected on alleged prior art of which Applicant is unaware and that is not of record**, but rather **seemingly** based on the Examiner's **personal knowledge** and **opinion** of what is well-known art without any

corroborating documentary evidence. Since "[a] second or any subsequent action on the merits in any application … should not be made final if it includes a rejection, on prior art not of record" (please see MPEP 706.07), Applicant respectfully submits that these rejections cannot be maintained and the finality of this Final Office Action is premature. Withdrawal of the finality of this rejection is respectfully requested.

A Petition Under 37 CFR 1.181 To The Technology Center Director, a Petition Fee Transmittal, and the appropriate fee are attached to this paper. If it is found that no petition fee actually is due, please reimburse Deposit Account No. 50-1848. If any additional fee is due, please charge our Deposit Account No. 50-1848, under Order No. 010684.0103PTUS from which the undersigned is authorized to draw.

Respectfully submitted,
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